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10/765,997	01/29/2004	Shinpei Okajima	SN-US035209	2012

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EXAMINER

BELLINGER, JASON R

ART UNIT PAPER NUMBER

3617

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/765,997

Applicant(s)

OKAJIMA, SHINPEI

Examiner

Jason R Bellinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reinforcement members being bonded to the spoke attachment portion of the rim by brazing, as set forth in claims 1-3, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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***Claim Objections***

2. Claim 1 is objected to because of the following informalities: In line 11 of the claim, a colon (:) should be inserted after the term "including" for grammatical clarity. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry. Terry shows a bicycle rim *H* having an annular tire attachment portion for mounting a tire *I* thereon, and an annular spoke attachment portion fixedly coupled with the tire attachment portion. The spoke attachment portion includes a plurality of circumferential spaced attachment openings. A plurality of reinforcement members *F* is coupled to the spoke attachment portion at the attachment openings to effectively increase the thickness of the spoke attachment portion.

Each reinforcement member *F* has a base portion that includes a rim-facing surface that is in contact with an outer surface of the spoke attachment portion of the rim *H*, an exterior-facing surface facing in the opposite direction from the rim-facing surface, and a through opening extending between the rim-facing and exterior-facing surfaces that is aligned with an attachment opening.

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Terry does not show the reinforcement members  $F$  being bonded to the spoke attachment portion of the rim  $H$  around an outer periphery of the reinforcement member through a process such as brazing, which involves melting metal to form a bond between the mating surfaces. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to braze the reinforcement members  $F$  to the spoke attachment portion of the rim  $H$  for the purpose of providing a permanent reinforcement at the spoke mounting areas, and to reduce the number of parts required to assemble the wheel.

Terry shows each reinforcement member  $F$  including a tubular section  $f$  extending through the attachment opening. Terry does not show the tubular section  $f$  of the reinforcement member having internal threads formed therein. Terry does show an additional insert  $E$  having internal threads  $e$  for securing the spokes  $D$ . Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the internal threads in the tubular section  $f$  without including the additional insert  $E$ , for the purpose of reducing the number of parts required to attach the spokes  $D$  to the rim  $H$ .

Each of the reinforcement members  $F$  has an annular peripheral edge defined by the base portion that forms a step between the base section and the outer surface of the spoke attachment portion of the rim  $H$ . The annular peripheral edges of the reinforcement members  $F$  include a tapering portion (the downwardly sloping edge

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shown in Figure 1) and a radial part (the end portion at the bottom of the rim as shown in Figures 1-2).

The rim-facing surface of the reinforcement members *F* has a U-shaped contour that corresponds to the contour of the outer surface of the spoke attachment portion. Terry shows the reinforcement members *F* being an integrally formed one-piece, unitary member. The attachment openings are formed in an inner annular section such that the central axes of the openings extend generally in a radial direction.

Each reinforcement member *F* has a maximum overlapping dimension that overlaps the annular spoke attachment portion as measured from an outer peripheral edge to a respective attachment opening. The maximum overlapping dimension is at least half as large as a maximum transverse dimension of the attachment openings.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terry in view of Dixon et al. Terry contains all of the limitations as set forth in paragraph 3 above, but does not show the spoke attachment portion including a pair of annular side sections and an inner annular section to form a substantially U-shaped cross-sectional shape with an annular hollow area.

Dixon et al teaches the use of a rim 1 having a spoke attachment portion with a pair of annular side portions and an inner annular section that forms a generally U-shaped cross-sectional shape with an annular hollow area. The central axes of the attachment openings extend in a substantially radial direction of the rim 1. The tire

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attachment portion includes an annular bridge section that extends between a pair of annular tire support sections to form a substantially U-shaped cross-section.

Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the rim of Terry with the shape as taught by Dixon et al for the purpose of allowing a pneumatic tire to be mounted on the rim.

5. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry in view of Dixon et al as applied to claim 16 above, and further in view of Lacombe et al. Terry as modified by Dixon et al does not show the annular bridge section of the rim being free of openings except for a single valve aperture. Lacombe et al teaches the use of a bicycle rim having an annular bridge section devoid of any openings except for a valve opening.

Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the bridge section of the rim of Terry as modified by Dixon et al for the purpose of providing an airtight and easily sealable rim.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 4, 14, 16, and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 17, and 18, respectively, of copending Application No. 10/430,396. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the instant claims are included in the patented claims. The instant claims are broader in scope than the copending claims, and it is therefore obvious that the Applicant is claiming the same invention in broader terms. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered to show spoke aperture reinforcement members having a tube member that extends into the aperture of the rim. For example, Smith is considered to show a reinforcing member of the type described above.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R Bellinger whose telephone number is 703-308-6298. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger  
Examiner  
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